

REMARKS

In the final Office Action dated July 21, 2001, the Examiner rejected claims 16, 17, 20, 22, 23, 25-28, 32 and 33 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (US 2002/0129926) in view of Rotter (US 5,351,664).

Applicant submits that the references do not render the present application unpatentable in that the references lack all of the features of the claimed invention. A combination of the references, based on their teachings, would not result in the structure set forth in the present claims.

In the Advisory Action of November 22, 2010, the Examiner stated that the arguments presented in applicant's Response filed on September 21, 2010 were more specific than what is required by the limitations set by the claims.

In this Response, applicant has more distinctly and clearly defined the invention in each of the independent claims to address the points raised by the Examiner.

In particular, independent claim 16 defines structure that is not shown or suggested in the base reference Yamaguchi.

The claim defines the oil module as being provided with at least two channels for guiding oil and at least one channel for guiding water, one of the two oil channels being an oil cooler bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. Claim 16 now specifically defines that in operation a first partial flow of the oil flows through the oil cooler and a second partial flow of the oil flows through the oil cooler bypass channel bypassing the oil cooler, such that the partial flow of the oil flowing through the oil cooler bypass channel is caused to avoid flowing through the oil cooler.

The Examiner identified channel (23) of Yamaguchi as an oil bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. Oil flowing through channel 23 of Yamaguchi has already flowed through the oil cooler on its way from the oil inlet (or will be directed to the oil cooler if the oil is flowing in an opposite direction). The oil inlet in Yamaguchi is identified at element 19 which appears in the top right corner of figure 1. The only channel connected to the oil inlet 19 is the oil passage 39a which meanders through the oil

cooler (paragraph [0025] lines 13 – 15). Only after the oil has passed completely through the oil cooler does it enter into the oil passage 39b formed in the oil turning passage 25a, and then enter the through hole 23 where it flows to the oil outlet. Thus, through hole 23 is not an oil cooler bypass channel as required by the claim. Oil flowing through channel 23 is not caused to avoid flowing through the oil cooler. Yamaguchi does not permit oil to bypass the oil cooler, but instead requires all of the oil to always flow completely through the oil cooler. Yamaguchi teaches only a single flow path for the oil and does not teach a first partial flow of oil flowing through the oil cooler and a second partial flow of oil bypassing the oil cooler.

As stated in the current specification, when oil is cold, and more viscous, a bypass channel is important to allow the oil to not be subjected to cooling, but rather to bypass the oil cooler. As the oil heats up and becomes less viscous, more of the oil flows through the oil cooler, thus reducing the temperature of the oil to prevent thermal damage to the oil. In the case of Yamaguchi, all of the oil is required to flow through the oil cooler all of the time. None of the oil ever bypasses the oil cooler.

The Examiner relies on the teachings of Rotter only for a showing of an oil cooling device wherein an oil filter is attached to a carrier of the cooling device. Rotter is not relied on for a showing of the structure missing from Yamaguchi as discussed above.

The deficiencies of Rotter relative to the structure defined in the claim were discussed at length in applicant's previous responses filed April 6, 2010 and April 26, 2010, and are repeated here by reference.

In view of the foregoing, applicant submits that a combination of Yamaguchi and Rotter does not render claim 16, or any of its dependent claims unpatentable.

Applicant has also more clearly and distinctly defined the invention in claim 17, and has specifically defined the thickness of the oil cooler base plate as extending from the oil cooler side to the carrier element side. The Examiner states that Yamaguchi discloses a slit "(25a)" extending over an entire thickness of the oil cooler base plate. Passage 25a is not a slit extending through the entire thickness of the base plate from one side to the other, but instead is shown and described as being formed as a depression in the plate.

An advantage of having the bypass channel extending through the oil cooler base plate, rather than being formed in a depression, is discussed at paragraphs [0036] and [0045] of the

present description, which is that the bypass channel may be manufactured together with the remaining base plate in one stamping operation. This advantage is not provided by the structure of Yamaguchi.

For this additional reason, applicant submits that claim 17 is patentably distinguishable over the references relied on by the Examiner.

With regard to independent claim 32, the structure defined in this claim also includes an oil cooler bypass channel as one of two channels connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. The operation of the oil module is described wherein a first partial flow of the oil flows through the oil cooler bypass channel bypassing the oil cooler such that the first partial flow of the oil flowing through the bypass channel is caused to avoid flowing through the oil cooler. The lack of such a bypass channel in Yamaguchi is discussed above and is repeated here by reference. The deficiencies of Rotter discussed above with respect to claim 16 are repeated here. For each of these reasons, considered separately or in combination, applicant submits that claim 32 is patentably distinguishable over the combination of Yamaguchi and Rotter as suggested by the Examiner.

With regard to independent claim 33, the structure defined in this claim also includes an oil cooler bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler (in addition to a channel for guiding oil and a channel for guiding water). The operation of the oil module is described wherein a first partial flow of the oil flows through the oil cooler and a second partial flow of the oil flows through the oil cooler bypass channel bypassing the oil cooler such that the second partial flow of the oil flowing through the bypass channel is caused to avoid flowing through the oil cooler. The lack of such a bypass channel in Yamaguchi is discussed above and is repeated here by reference. The deficiencies of Rotter discussed above with respect to claim 16 are repeated here. For each of these reasons, considered separately or in combination, applicant submits that claim 33 is patentably distinguishable over the combination of Yamaguchi and Rotter as suggested by the Examiner.

Applicant points out that each of the claims previously withdrawn due to a species election requirement depend directly or indirectly from independent claim 16. Since independent claim 16 is patentable, as discussed above, applicant submits that each of the

withdrawn claims should be reintroduced into the application and indicated to be allowable with the claims currently under consideration.

In view of the above discussion, applicant submits that all of the claims of the application are patentably distinguishable over the references relied on by the Examiner and applicant requests the Examiner to indicate that all of the claims (including the withdrawn claims) are allowed, and to pass the application to issue.

The original Response to the Final Action was filed within 2 months of the mailing date of the Final Action, and this Response is filed within 1 month of the mailing date of the Advisory Action, and therefore only a one month extension of time is believed to be required. Applicant petitions for the appropriate extension of time required for this response.

The Commissioner is hereby authorized to charge any additional fees which may be required for this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069.

Respectfully submitted,

/Kevin W. Guynn/ (Reg. No. 29,927)
Kevin W. Guynn
GREER, BURNS & CRAIN, LTD
Customer Account No. 24978
300 S. Wacker Drive, Suite 2500
Chicago, Illinois 60606-6771
Telephone (312) 987-2917
Attorneys for Applicant